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EXAMINER

BEX, PATRICIA K

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 09/13/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/496,408

**Applicant(s)**

SHIN ET AL.

**Examiner**

P. Kathryn Bex

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 7/9/2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8,10-28 and 40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8,10-28 and 40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Any rejection and/or objection not included herein have been withdrawn.
2. The cancellation of claims 32-39 is acknowledged and has been entered into the record.

#### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-8, 10-28 and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-8, 10-28 and 40 are incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: a heating means. Similarly, claims 27-28 are missing a "heated cover actuation means", see page 31, 2<sup>nd</sup> full paragraph.

Claims 19 and 40, the recite the term "sufficient". The recitation that an element is "sufficient" to perform a given function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense, see *In re Colianni*, 561 F.2d 220, 222-23, 195 USPQ 150, 152 (CCPA1977).

#### *Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1-2, 11-12, 19-20, 24-25 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Aysta *et al* (USP 5,464,541).

Aysta *et al* teach a device and method for separating liquid samples. The apparatus comprising a sample block 44, 50 having a plurality of recesses 32 for receiving sample wells of a sample well tray 54, 58, wherein the sample wells of sample well tray 54, 58 are configured to contain a sample (column 8, lines 27-31). Aysta *et al* teach the use of a least one urging mechanism 46 interposed between the sample block and the sample well tray and which will impart an urging force on the sample tray when the cover 64 is removed. Moreover, Aysta *et al* teach a modular sample well tray holder 52 for holding the sample well tray (column 8, lines 28-54, Fig. 5). Note: the process limitations describing wherein the urging mechanism urges the sample wells away from the opening in the sample block upon removal of a pressing force imparted on the top of the sample well tray has not been given patentable weight. Process limitations are not accorded patentable weight in a claim which is drawn to an apparatus. Moreover, no means for providing a pressing force to the top of the sample well tray is disclosed within the claim.

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With respect to the newly claimed wherein clause in claim 40, the prior art device would have been fully capable of performing the same function. No structural limitations are disclosed and therefore the claim has not been accorded patentable weight.

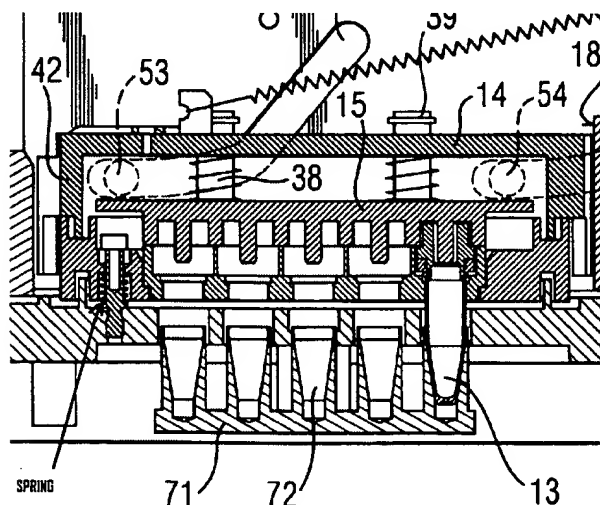
8. Claims 1-8, 11-15, 19-28 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Root *et al* (USP 4,948,564).

Root *et al* teach a multi-well filter plate and assemblies. The apparatus comprising a multi-well plate 18 and multi-well plate holder 201 for holding the multi-well plate. Additionally, the apparatus includes a sample block 76 having a plurality of recesses 78 for receiving sample wells 20 of multi-well plate, wherein the sample wells 20 of multi-well plate are configured to contain a sample until the pressure system applies an increased pressure above the membranes 34 to *force* the samples in wells 20 through the membrane (column 8, lines 24-27, Fig. 14). Root *et al* teach the use of a plurality of springs 204 distributed over the outer periphery of the sample block surface. The springs are interposed between the sample block and the multi-well plate and inherently function to lift the multi-well plate upon removal of the cover 202 (column 7, line 59-column 8, line 65, Figs.14-15). Note: the process limitations in claim 1 and 40 are not accorded patentable weight in a claim which is drawn to an apparatus for the reasons previously discussed above. With respect to the wherein clauses of claims 27 and 28, the device of Root *et al* would be fully capable of performing the same function, see Fig. 14. Specifically, the sample well tray holder 201 may be pressed downward by the cover 202, i.e. when a cover actuating means presses the cover. This would impart a downward force, via the upper set of springs 204, to the sample well tray holder 201 so that the sample well tray 18 could become disengaged from the sample well tray holder

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9. Claims 1-8, 10-15, 19-26 and 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Schneebeli *et al* (USP 6,197,572).

Schneebeli *et al* teach a thermal cycler having an automatically positionable lid. The apparatus comprising a sample well tray 11 and sample well tray holder 66 for holding the sample well tray, wherein the sample wells 13 of the sample well tray is configured to hold sample. Additionally, the apparatus includes a sample block 71 having a plurality of recesses 72 for receiving sample wells of sample well tray (Fig. 3). Schneebeli *et al* teach the use of a plurality of springs (see modified Figure 2 below) distributed over the outer periphery of the sample block surface (Figs. 2, 8). The springs are interposed between the sample block and the sample well tray and inherently function to lift the multi-well plate upon removal of the cover 14 (column 3, line 55-column 5, line 16, Figs.1-2, 8-10). Note: the process limitations in claim 1 and 40 are not accorded patentable weight in a claim which is drawn to an apparatus for the reasons previously discussed above.



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10. Claims 1-2, 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Moser *et al* (USP 5,616,301).

Moser *et al* teach a thermal cyclers apparatus. The apparatus includes a cover 28, a sample block 33 having a plurality of recesses 27 for receiving sample wells 21 of a sample well tray 23, wherein the sample wells are configured to hold samples. Moser *et al* teach the use of a least one urging mechanism 53 which is configured to impart an urging force on the sample tray when the heated cover 28 is opened beyond a certain angle. The urging mechanism is interposed between the sample block and the sample well tray and provided to facilitate removal of the sample wells from the sample block (column 5, line 35- column 6, line 11, Figs. 3-5). Note: the process limitations in claim 1 and 40 are not accorded patentable weight in a claim which is drawn to an apparatus for the reasons previously discussed above.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
13. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Root *et al* (USP 4,948,564) or Schneebeli *et al* (USP 6,197,572) in view of Schembri (USP 6,162,400).

Root *et al* and Schneebeli *et al* as previously discussed above, do teach the use of a coil spring. However, both are silent regarding the specific use of a leaf spring or the number of spring devices used. However, Schembri teaches the equivalence of a coil or leaf spring (column 5, lines 53-56).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to have substituted the coil spring of Root *et al* or Schneebeli *et al* with a leaf spring since they are art recognized equivalents.

Regarding the specific number of spring devices, it would have been obvious to include four spring devices in the apparatus of either Root *et al* or Schneebeli *et al* since it has been held that the mere duplication of parts has no patentable significance unless a new and unexpected is produced. *In re Harza*, 124 PQ 378 (CCPA 1960).

Moreover, Root *et al* and Schneebeli *et al* disclose the claimed invention except for the specific volume of the sample wells in the sample well tray. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the sample wells of Root *et al* or Schneebeli *et al* within the range of 10 to 500 microliters, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

#### ***Response to Arguments***

14. Applicant's arguments filed July 9, 2002 have been fully considered but they are



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not persuasive. With respect to the previous rejection of claims 1-8, 10-28 and 40 under 35 U.S.C. 112, second paragraph, Applicant argues that is not necessary to recite every element necessary to build a fully functioning heating apparatus. Examiner does not agree, since the preamble recites a *heating apparatus* and the body of the claim fails to disclose any heating means. The recitation “a heating apparatus” has not been given patentable weight because the recitation occurs in the preamble. Applicant is reminded that a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone (emphasis added). See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Moreover, regarding the rejection of claims 19 and 40, Applicants seem to argue that that “sufficient” is not a positive recitation, see page 5, line 4. Examiner directs Applicant’s to *In re Colianni*, 561 F.2d 220, 222-23, 195 USPQ 150, 152 (CCPA1977).

With respect to the rejection of claims 1-2, 11-12, 19-20, 24-25 and 40 under 35 U.S.C. 102(b) as being anticipated by Aysta *et al* (USP 5,464,541), Applicants argue the structural elements 44 and 50 cannot both comprise a sample block as recited in claim 1. Examiner does not agree since the sample block is defined as having a plurality of openings for receiving wells of sample well tray, and reference no. 44 is a rectangular bottom housing part which accommodates a rack 50 (column 8, lines 33-41). Moreover, the transitional term “comprising” is inclusive or open-ended and does not exclude additional, unrecited elements. See, e.g., *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495,501, 42 USPQ2d 1608, 1613 (Fed. Cir.

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1997) (“Comprising” is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.); *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); *Ex parte Davis*, 80USPQ 448, 450 (Bd. App. 1948) (“comprising” leaves “the claim open for the inclusion of unspecified ingredients even in major amounts”). See MPEP 2111.03.

Applicant argues that Aysta et al refers to “vertical wells 58” at column 8, lines 50+, however these are not in fact “wells” as commonly used since they do not have a closed bottom to keep the sample in the “well”. Contrary to Applicant’s assertions, the term “wells” are known and accepted within the art to include vessels with or without a closed bottom end. Moreover, Aysta et al do teach sample wells configured to contain a sample until a partial vacuum is generated in chamber 66 and the liquid samples in wells 58 are suctioned through the openings (column 9, lines 8-12). Additionally, the recitation of the sample wells being configured to contain a sample is a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim (emphasis added). In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). This same reasoning is applicable to the arguments presented by Applicant with respect to Root et al (USP4,948,564). In Root et al, the sample wells 20 of multi-well plate are configured to contain a sample *until* the pressure system applies an increased pressure above the

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membranes 34 to *force* the samples in wells 20 through the membrane (column 8, lines 24-27, Fig. 14), thereby meeting the structural limitations of the claim.

Applicant argues that element 46 is a “seal” of Aysta et al and does not impart an urging force on the sample well tray. Examiner points out the specification defines the urging mechanism as washers at page 15, lines 13-19. Washers are known and accepted within the art as sealing means. Moreover, Aysta et al do disclose supporting frame member 52 carries a rectangular block of material 54 disposed with its rim on a rubber seal 56 provided a supporting frame member 52, (column 8, lines 47-49). Aysta et al do teach both seals 46 and 56 providing an airtight seal in the chamber (column 9, lines 6-7). Rubber seals inherently provide an upward force when compressed.

With respect to the previous rejection of claims 1-8, 10-15, 19-26 and 40 under 35 U.S.C. 102(e) as being anticipated by Schneebeli *et al* (USP 6,197,572), Applicant argues that because Schneebi et al teaches a completely separate device (e.g. ejector device) for separating the vessels from the chambers, the springs referred to by the Examiner obviously do not function to lift the multi-well plate upon removal of the cover 14. Examiner does not agree with the reasoning presented by the Applicant, since the springs are interposed between the sample block 71 and the sample well tray 11, and thereby it meets the structural limitations of the claim (see modified Figure 2 above). Moreover, the springs can act *in addition* with the ejector means to lift the multi-well plate upon removal of the cover 14 (column 3, line 55-column 5, line 16, Figs.1-2, 8-10).

With respect to the previous rejection of claims 1-2, 19-20 under 35 U.S.C. 102(b) as being anticipated by Moser *et al* (USP 5,616,301), Applicant argues that claim 1 requires the

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urging mechanism to be operative “upon removal of a pressing force”, but Moser et al teaches the lifting-out device 53 being operative only after the removal of the pressing force. Examiner does not understand this argument since the lifting out device 53 need only be operative when the lid 28 is open, thereby meeting the functional recitation of the claim.

***Conclusion***

15. No claims allowed.

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Kathryn Bex whose telephone number is (703) 306-5697. The examiner can normally be reached on Mondays-Thursdays, alternate Fridays from 6:00 am to 3:30 pm EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 308-4037.

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The fax number for the organization where this application or proceeding is assigned is (703) 305-7718 or (703) 872-9310 for official papers prior to mailing of a Final Office Action. For after-Final Office Actions use (703) 872-9311. For unofficial or draft papers use fax number (703) 305-7719. Please label all faxes as official or unofficial. The above fax numbers will allow the paper to be forwarded to the examiner in a timely manner.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

*Kathryn Bex*

P. Kathryn Bex  
Patent Examiner

AU 1743

September 10, 2002

*Jill Warden*

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